

RESPONSE UNDER 37 C.F.R. § 1.116

EXPEDITED PROCEDURE – Art Unit 3621

Attorney Docket No. 108298627US

Disclosure No. MUEI-0533

REMARKS

Claims 1-29 were pending in the application at the time the present Office Action was mailed. No claims have been amended, cancelled, or added by this response. Accordingly, claims 1-29 remain pending in the present application.

The status of the claims in view of the present Office Action is as follows:

(A) Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,438,508 to Wyman ("Wyman") in view of applicant's own admission.

The undersigned attorney wishes to thank the Examiner for engaging in a telephone interview on June 9, 2004, to discuss the present Office Action. During the course of the interview, the undersigned attorney and the Examiner discussed some of the distinctions between the pending claims and the teachings of the Wyman reference. For example, one distinction discussed was the data access authorization of the pending claims. This authorization is stored on a user computer system. In contrast, the licenses taught by Wyman are stored on a remote server computer. The following remarks summarize and expand on this and other points raised during the June 9 telephone interview.

A. Response to the Section 103 Rejection of Claims 1-29

Claims 1-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wyman in view of applicant's own admission regarding AOL in the Background section of the present application. A properly framed obviousness rejection requires, *inter alia*, that the combined prior art references teach or suggest *all* the claimed features. (MPEP 706.02(j); emphasis added). As discussed in greater detail below, independent claims 1, 10, and 21 all include the feature of recording an authorization to access data *in the same computer system* in which the data is stored. In contrast, Wyman teaches recording a license to access a software application *in a remote license server*. Furthermore, the AOL reference fails to cure this deficiency of Wyman with respect to independent claims 1, 10, and 21. Therefore, Wyman and the AOL reference cannot

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support a Section 103 rejection of claims 1, 10, and 21 for at least the reason that these references, either alone or in combination, fail to teach or suggest *all* the claim features. Accordingly, the rejection should be withdrawn.

1. Claim 1 is Directed to a Method of Distributing Software With a Computer System That Includes, *inter alia*, Recording a Data Access Authorization *in the Computer System*

Claim 1 is directed to a method of distributing software with a computer system. The method includes, *inter alia*, recording data on a fixed medium in the computer system, and providing for transfer of the computer system to a user. Access to the data in the computer system is controlled by contacting a party authorized to grant access to the data in response to receiving a first request for access to the data. If the party authorizes access to the data, then the authorization is recorded *in the computer system* and access to the data is granted based on the recorded authorization. If the computer system receives additional requests for subsequent access to the data, the computer system grants access to the data based on the authorization previously recorded *in the computer system*.

Independent claim 10 is directed to a software module used in a computer system that controls access to a software application stored on a fixed medium in the computer system. The software module verifies authority to access the software application by, *inter alia*, contacting a party authorized to grant access to the software application. If the party provides authorization to grant access to the software application, the authorization is recorded *in the computer system* and access is granted based on the recorded authorization. If subsequent access to the software application is detected, subsequent access is granted based on the authorization recorded *in the computer system*.

Independent claim 21 is directed to a computer system operable to provide controlled access to a software application stored on a fixed medium in the computer system. The computer system includes, *inter alia*, a software module that responds to a first activation of the software application by contacting a party authorized to grant

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access to the software application. If the party provides authorization to grant access to the software application, the software module records the authorization *in the memory of the computer system*. If subsequent activation of the software application is detected, subsequent access is granted based on the authorization recorded *in the memory of the computer system*.

2. Wyman is Directed to a License Management System That Stores Licenses (Product Use Authorizations) on a Remote License Server

Wyman is directed to a license management system that controls software product usage in a computer system. In Wyman, the licenses are stored *on a server computer* that administers the licenses, and each licensed product makes a call *to the server computer* upon start-up to determine whether use is permitted. Quoting from Wyman:

"[T]he license server maintains a store of the licenses, called product use authorizations, that it administers. Upon receiving a call from the user, the license server checks the product use authorization to determine if the particular use requested is permitted, and, if so, returns a grant to the requesting user node. The license server maintains a database of product use authorizations for the licensed products, and accesses this database for updating and when a request is received from a user."

(Wyman at column 6, lines 57-66; underlining added).

3. Wyman and Applicant's Own Admission Cannot Support A Section 103 Rejection of Claims 1-29 for at least the Reason that These References Fail to Teach or Suggest Recording a Data Access Authorization in a Client Computer System

Independent claims 1, 10, and 21 all include the feature of recording a data access authorization *in the same computer system in which the data is stored*. In contrast, Wyman teaches recording a license *in a remote license server*. To overcome this shortcoming, the Office Action ignores the licenses and initially attempts to construe Wyman's *handle* as the claimed data access authorization. Specifically, the Office Action states "Wyman ... discloses storing the authorization handle on the client computer for future reference." (Office Action at pg. 6; emphasis added).

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The handle taught by Wyman, however, *is not* a data access authorization. Indeed, as Wyman explains, the handle merely identifies the allocation grant created by a previous call to request allocation of a license. By using a handle, a subsequent request for access is expedited by the server because the handle identifies the allocation granted during a previous call. (Wyman at column 22; lines 14-36). As Wyman further explains "If the handle is valid, the authorization for the product is retrieved from the [server] database 23." (Wyman at column 23, lines 66-67; word in brackets and underlining added.) Thus, the handle of Wyman cannot be construed as the authorization because Wyman explicitly states that 1) the authorization and the handle are two different things, and 2) the authorization is stored in the server database, whereas the handle is stored on the user computer.

Elsewhere in the Office Action, the Office Action appears to acknowledge that the handle taught by Wyman cannot be construed as the access authorization of the pending claims. Specifically, on page 3 the Office Action states "...Wyman does not specifically disclose an authorization per se recorded on the user's hard drive." The Office Action goes on to state, however, that:

"...one of ordinary skill in the art [would] conclude that it is an obvious modification to store authorization data on a hard drive in light of AOL's technique of pre-loading software onto a computer before the computer [is] shipped to [a] user and Wyman's use of storing an authorization handle on the computer's hard drive." (Office Action at page 3).

This unsupported assertion is insufficient to form the basis of a proper Section 103 rejection of claims 1, 10, and 21 for a number of reasons. First, the MPEP requires that the applied references teach or suggest all the features of the pending claims. (MPEP 706.02(j)). Even assuming (and applicant expressly does not) that there was some motivation *in the prior art* to combine Wyman with the AOL reference, this combination would still fail to produce the claimed invention because neither of these references teach or suggest the access authorization feature of the pending claims. All Wyman teaches in this regard is storing a handle on a user computer. All the AOL reference teaches in this regard is storing software on a user computer. Accordingly, combining these two references still fails to teach storing the authorization of the

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pending claims on a user computer. Indeed, as set forth above the Office Action expressly acknowledges that Wyman does not disclose this feature. Further, the Office Action only relies on the AOL reference to teach pre-loading software onto a user computer. Absent the access authorization feature, the applied references cannot support a Section 103 rejection of claims 1, 10, and 21 even if combined. Accordingly, the rejection should be withdrawn.

Second, the MPEP also requires that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found *in the prior art and not based on applicant's disclosure.*" (MPEP 706.02(j); emphasis added). Even assuming (and applicant expressly does not) that the applied references do teach all the claimed features, nowhere has the Office Action identified where *the prior art* suggests combining the AOL reference with Wyman. All the Office Action states in this regard is:

"... it is an obvious modification to store authorization data on a hard drive in light of AOL's technique...and Wyman's use of storing an authorization handle" (Office Action at page 3).

Here, the fact that the Office Action states "it is" an obvious modification, rather than the legal standard of "it would have been" an obvious modification at the time of the invention, suggests that the Examiner is using an impermissible hindsight analysis in view of the present disclosure to provide the missing features of the pending claims. Even still, without more, the conclusory assertion that "...it is an obvious modification..." still fails to identify where *the prior art* suggests the claimed combination. Absent a suggestion in the prior art, the applied references cannot support a Section 103 rejection of claims 1, 10, and 21. Accordingly, the rejection should be withdrawn for this additional reason.

In an apparent attempt to provide further support the assertion that the claimed invention is obvious, the Office Action goes on to state "It would be of little burden or consequence to the public to modify these techniques to store a complete authorization on a user's computer." (Office Action at page 3). Applicant disagrees with this

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assertion, and further, applicant is unaware that the legal standard for obviousness is based on whether "it would be of little burden to modify" the prior art to produce the claimed invention. To the contrary, a proper *prima facie* rejection under Section 103 requires, *inter alia*, that 1) the applied references teach or suggest *all* the claim features, and 2) the teaching or suggestion to make the claimed combination and the reasonable expectation of success be found *in the prior art*. (MPEP 706.02(j); emphasis added). As set forth above, the applied references of Wyman and the AOL reference fail to teach or suggest all the claim features. Further, the Office Action has failed to identify where the prior art suggests combining the AOL reference with Wyman. Accordingly, the Office Action has failed to establish a *prima facie* obviousness rejection of independent claims 1, 10, and 21. Therefore, the Section 103 rejection of these claims should be withdrawn.

Claims 2-9 depend from base claim 1. Claims 11-20 depend from base claim 10. Claims 22-29 depend from base claim 21. Accordingly, Wyman and applicant's own admission cannot support a Section 103 rejection of dependent claims 2-9, 11-20, and 22-29 for at least the reasons discussed above with regard to the Section 103 rejection of the corresponding base claims, and for the additional features of these dependent claims. Accordingly, the rejection of dependent claims 2-9, 11-20, and 22-29 should be withdrawn.

VI. Conclusion

In view of the foregoing, the claims pending in the application comply with 35 U.S.C. § 112 and patentably define over the applied art. Therefore, a Notice of Allowance is respectfully requested. If the Examiner has any questions or believes another telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned attorney at (206) 359-6351.

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Respectfully submitted,

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